REMARKS

Claims 1-4, all the claims pending in the application, stand rejected. Applicant has amended claim 2 in order to use better grammar and to place the claims in better form for appeal. Applicant also has added new claims 5 and 6.

Claim Objection

Claim 2 is objected to because the Examiner believes that the phrase "melody unit" appears in the claim, and the Examiner finds that the phrase has insufficient antecedent basis. Applicant would question the Examiner's basis for this objection, as there is no such phrase in claim 2. A phrase "melody until" appears and that is quite proper.

Applicants notes that other words in claim 2 may be changed for better grammar and tense. In particular, the language would be better stated as "to generate an image for display and renew said displayed image..." This change has been made.

Claim Rejections - 35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Miyaki et al (2001/0055464). This rejection is traversed for at least the following reasons.

The Examiner simply repeats the text of the rejection from the Office Action dated June 28, 2005. In response to Applicant's arguments for patentability, the Examiner makes two points in the Response to Arguments portion of the final Office Action at page 5. In particular, the Examiner:

- Asserts that since the term "creation" appears in the preamble, it has not been given patentable weight since the body of the claim does not depend on the preamble for completeness but the structural limitations are able to stand alone.
- Notes Applicant's argument that none of the cited portion of Miyaki et al concerns the creation of melody and image synchronous information. The Examiner states, however, that all of the subject matter recited in the claim is

taught or suggested or disclosed, as explained in sections 3 and 4 of the Office Action.

Point 1

Claim 1 is expressly directed to a creation system for synchronized melody and image information. The claim must be interpreted as directed to a creation system for two reasons.

First, as to the Examiner's point that the limitation "creation" appears in the preamble, Applicant respectfully submits first that the Examiner cannot look at one word, but must look at the device defined by the claim. That device is defined by the limitation "creation system of melody and image synchronous information" in the preamble. In defining the device, the entire preamble clearly is intended as a claim limitation, and should be considered as such by the Examiner in the light of a consistent line of cases decided by the CAFC. Specifically, supporting the significance of preamble limitations as a basis for defining the scope of the claimed subject matter is *In re Paulsen*, 31 USPQ2d 1671, 1672-74 (Fed. Cir. 1994) where the CAFC reversed the USPTO decision and held that the word "computer" in the preamble was a limitation in the claims and that to anticipate the claim the prior art must disclose a computer. See also *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). This approach extends far back to earlier CCPA cases where the court in *In re Duva,* 156 USPQ 90 (CCPA 1967) found that the limitations of even intended use in the preamble should be considered in obviousness determinations. See also Chisum on Patents 3:8.06[1]. Clearly, in the present case, Applicant is relying on the preamble to define the claimed invention and that entire claim limitation ("creation system of melody and image synchronous information") is necessary to complete the definition of the invention in the claim and must be considered by the Examiner.

Second, Applicant again would assert that the claimed system includes an "event information insertion means." This is a "means plus function" limitation that meets the three prong test and is to be interpreted under 35 U.S.C. § 112, paragraph 6, in accordance with the guidelines stated in MPEP 2181. In further compliance with the guidelines, Applicant submits that the function of this "means" is for inserting event information and melody information at a

timing of image renewal, so that the image may be reproduced in synchronization with the melody. This structure corresponds to the melody and image synchronous generation system illustrated in Fig. 1, particularly the storage means 10 having melody data 12, image data 14 and a scheduled program 16 for controlling a schedule of timing at which the melody data and the image data are changed, respectively. A schedule making means 20 makes a reproduction schedule of the melody data by executing the scheduled program 16.

Thus, according to the requirements of 35 U.S.C. § 112, sixth paragraph and the Federal Circuit decision in *In re Donaldson* 16 F.3d 1189 (Fed. Cir. 1994) and the guidance in MPEP 2182, the Examiner must find a structure in the prior art that is limited to a creation system that creates melody and image synchronous information. The Examiner has not identified such teaching in Miyaki et al.

Third, the Examiner's reliance on the same teachings in Miyaki et al in the rejection of claims 2-4, which concern image reproduction and not creation, demonstrate that the cited teachings of Miyaki et al are not relevant by the Examiner's own admission.

Miyaki et al

The Examiner asserts that Miyaki et al teaches a creation system for melody and synchronous image information at section [0038], particularly lines 9-12, and section [0072], at lines 16-25. Applicant respectfully sumits that the Examiner has not even made a *prima facie* case for anticipation by Miyaki et al and, in any event, Applicant has rebutted the Examiner's position with sound technical reasoning that the Examiner has not overcome by simply repeating his rejection.

As previously pointed out by Applicant, Miyaki et al at Paragraphs [0036]-[0038] describes a system for reproducing object information in synchronization with the performance of a song, where the object information includes image information (still picture or moving picture). The device 1 in Fig. 1 of Miyaki et al reproduces the object information in synchronization with an internal or external clock signal. Thus, both of the music performance information of a song and the object information can be reproduced and outputted in the

synchronous information reproduction apparatus 1. An additional explanation of the manner in which reproduction of the song is accomplished is provided at Paragraphs [0070]-[0072].

Notably, none of this information concerns the actual creation of melody and image synchronous information. Thus, Applicant would again assert that the reference does not anticipate the present invention since it is only concerned with reproduction and not creation.

Claim Rejections - 35 U.S.C. § 103

Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Futamase et al (2004/0007120) in view of Miyaki et al (2001/0055464). This rejection is traversed for at least the following reasons.

The Examiner repeats the text of his rejection of claim 2 on the basis of Futamase et al. The Examiner continues to assert that Futamase et al teaches (1) melody generation means, with reference to paragraphs [0195] and [0196], (2) event information detecting means, with reference to paragraph [0203] and image generating means, with reference to paragraphs [0206] and [0207].

However, the Examiner also admits that Futamase et al does not mention expressly the functions of two of these limitations including (1) for the "melody generation means," the function that it "continues to provide melody information until said event information detection means detects event information," and (2) for the "event information detection means," the function that it "detects event information and causes said image generation means to generate an image for display and renew said displayed image until another event information is detected."

The Examiner now looks to Miyaki et al to remedy this admitted deficiency, and asserts that Miyake et al teaches such "melody generation means" and "event information detection means." The Examiner then finds the teachings combinable or at least suggesting a modification of Futamase et al on the basis of the cited sections of Miyaki et al. The Examiner's conclusion is erroneous for several reasons.

First, the limitations are "means plus function" limitations and must be interpreted in accordance with 35 U.S.C. § 112, sixth paragraph on the statutory and administrative bases already identified with respect to claim 1. Neither Futamase et al nor Miyaki et al teach the express functions of these limitations nor an identical or equivalent structure, as would be required under the *In re Donaldson* decision and USPTO guidelines cited above. The Examiner already admits this for Futamase et al. As for Miyaki et al, a comparison of the disclosed structure for the present invention and the cited structure of Miyaki et al will demonstrate that the reference also fails to disclose the claimed feature.

As to the relevant corresponding structure in the present application, these features relate to the structure in Fig. 1 wherein event timing detection means 30 receives melody data combined with scheduling data and controls the generation of sound by generator 50 as well as the timing of an image by controlling image timing control means 40 that is coupled to image generator 60. A combined audio and video output will result at speaker 70 and display panel 80. The processing illustrated in the flowcharts of Figs. 3 and 5 shows that the detection of event information, which is embedded in melody information, will result in the delivery of the event information to the image timing control means (S105, S204) followed by an instruction for image renewal (S106, S205). As a result, images are renewed (S107, S206) and the renewed images are displayed (S108, S207). Where there is no event information detected, the melody information is simply delivered to the melody generator and outputted (S103, S104; S202, S203).

Applicant respectfully submits that there is no comparable function in Miyaki et al. In particular, there is no teaching of (1) event information that is (2) inserted in melody information and (3) controls image information in the manner claimed. As expressly stated in the claim, the "event information is inserted in the melody information," as illustrated in Fig. 2. Notably, the claim further states that the detection of event information causes the image generation means to generate an image for display and renews the image until another event information is detected. Nothing of this sort is taught in Miyaki et al.

Miyaki et al

The Examiner again refers to the teaching of Miyaki et al at paragraphs [0038] and [0072] for a teaching of a synchronous information reproduction apparatus for "providing melody information on a continuous basis, detecting event information and generating an image for display and renewing said display image until another event information is detected."

Miyaki et al at paragraph [0038] simply refers to the possible sources of a clock signal for reproduction of information as being an external source 2 or a timing clock of a MIDI message (music performance information). It also has a generic discussion of the reproduction of both music performance information and object information by synchronous reproduction apparatus 1 on the basis of the timing information. However, there is no further discussion of how the object and song information is related, nor any disclosure of an embedding of event information in melody information, as claimed.

At best, paragraph [0039] specifies that the start/end of the performance or information for selecting a song to be performed is provided by the external clock device 2 (external synchronous mode discussed at paragraph [0040]) together with a clock signal from the MIDI message that reflects the tempo of the music being played (internal synchronous mode discussed at paragraph [0041]). However, this does not teach the feature of using event information that is inserted into a melody information to control a display in the manner claimed or, more specifically with respect to the claims, the provision of melody until event information is detected and then the generation of an image for display coupled with renewal until another event information is detected.

Miyaki et al at paragraph [0072] describes the starting operation of the information reproduction apparatus 1 (or PC serving as a main body), the selection of a song by an operator (F3) designation of a song number (ID), the use of FF, REW and song position pointer F2. The text at lines 16-25 of paragraph [0072] that is relied upon by the Examiner concerns an external START signal that is transmitted from an external source 2 along with timing clock F8, channel

message EF. The text simply describes the reproduction of an object information and music performance information on the basis of a clock F8. However, this does not teach the limitation that the Examiner admits is missing from Futamase et al.

In sum, the specific features of the invention clearly are distinguishable from Futamase et al and Miyaki et al. The present invention is simpler than that in Futamase et al and Miyaki et al, particularly with respect to the manner in which the processing according to the flowcharts in Figs. 3 and 5 is performed. For example, the delivery of melody information on a continuous basis until event information is detected at step S102 and S201, respectively, and the delivery of image information until a new event information is detected, remain a clear basis for asserting patentability.

The Examiner looks to the disclosure in Futamase et al for teachings relevant to claims 3 and 4, but as already admitted by the Examiner, Futamase et al fails to teach the basic structure and function in parent claim 2. Thus, claim 2 and the claims dependent thereon are patentable.

New Claims

Applicant has added new claims 5 and 6 in order to define the invention in means plus function terminology. Clearly, none of the prior art teaches the recited functions nor the corresponding structures for the several limitations in the claims. All of these claims are clearly patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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